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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,167

11/26/2003

Yong-hwan Park

101-R001

7516

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EXAMINER

GLEITZ, RYAN M

ART UNIT

PAPER NUMBER

2852

MAIL DATE

DELIVERY MODE

05/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,167

Applicant(s)

PARK, YONG-HWAN

Examiner

Ryan Gleitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-25 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 is/are allowed.
- 6) ☒ Claim(s) 21, 23-26 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment to the claims filed on 5 April 2007 do not comply with 37 CFR § 1.173(g), which requires “[a]ll amendments must be made relative to the patent specification, including the claims, and drawings.” This rule does not apply only to the first reissue amendment. “All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and not relative to the prior amendment.” MPEP §1453. The recent amendment represents changes relative to the previous amendment rather than the issued patent.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21, 23-26, and 29-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The material not described in the Specification includes “a surface potential changing unit to expose the surface of the photosensitive drum” as recited in claim 21 at line 5, claim 25 at line 5, claim 29 at line 5, claim 32 at line 5, and “a pre-transfer exposing device. . . to expose a surface of a photosensitive member” in claim 33, lines 1-4.

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Rather than a pre-transfer exposing device or a charging unit to expose the surface of the photosensitive drum, the Specification discloses that the PTL (pre-transfer lamp) is intended to “lower the potential of the toner coated on the photosensitive drum,” col. 4, line 67 - col. 5, line 1. See also claims 1-20.

Claim Rejections - 35 USC § 251

Claims 21, 23-26, and 29-33 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent includes, “a surface potential changing unit to expose the surface of the photosensitive drum” as recited in claim 21 at line 5, claim 25 at line 5, claim 29 at line 5, claim 32 at line 5, and “a pre-transfer exposing device. . . to expose a surface of a photosensitive member” in claim 33, lines 1-4.

Rather than a pre-transfer exposing device or a charging unit to expose the surface of the photosensitive drum, the Specification discloses that the PTL (pre-transfer lamp) is intended to “lower the potential of the toner coated on the photosensitive drum,” col. 4, line 67 - col. 5, line 1. See also claims 1-20.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Fox (US 4,561,761).

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Fox discloses a charge erase device (12), which reads on a light guide member, as shown in figure 2 to spread received light in a scan direction of the photosensitive member (15) and to collect the received light [from lamp 78] in a direction perpendicular to the scan direction.

Allowable Subject Matter

Claims 1-20 are allowed.

Response to Arguments

Applicant's arguments filed 4 May 2007 ("Response") have been fully considered but they are not persuasive.

Regarding the objection to an amendment not in compliance with 37 CFR §1.73(g), Applicant did not respond.

Regarding the rejections under 35 USC §112 and 35 USC §251, Applicant is thanked for pointing out a typographical error in which the quotation of claim limitation "changing" was reproduced in the rejections as "charging." Response, p. 10. The error was inadvertent and the analysis is not effected.

Regarding the rejections under 35 USC §112 and 35 USC §251, Applicant asserts that because the prior patent discloses that the PTL "lowers the potential of the toner coated on the photosensitive drum by exposing the drum surface to light of 650 nm wavelength generated by the PTL" that proper support is provided for the claim limitations "a surface potential changing unit to expose the surface of the photosensitive drum" as recited in claim 21 at line 5, claim 25 at line 5, claim 29 at line 5, claim 32 at line 5, and "a pre-transfer exposing device. . . to expose a surface of a photosensitive member" in claim 33, lines 1-4.

The prior patent at col. 4, line 67 reads, “[t]he light of 650 nm wavelength generated at the PTL 112 is scanned onto the surface of the photosensitive drum 103 to lower the potential of the toner coated on the photosensitive drum 103, thereby decreasing the engagement force of the toner to the photosensitive drum 103 and enhancing the transfer efficiency.”

Applicant’s characterization of the disclosure departs from the prior patent in two respects. First, Applicant asserts that the PTL is used for “exposing the drum.” Response, p. 10. The prior patent does not use the terms expose or exposing. “Exposing” is a term of art that refers to forming a latent image on a photoconductive drum. Applicant’s PTL is not for exposing. It is for increasing toner transfer efficiency. Col. 5, lines 1-3. Additionally, the location of PTL 112 is not appropriate for exposure. Second, Applicant asserts that the PTL lowers the potential of the toner coat and “ultimately the surface of the photosensitive drum.” Response, p. 10. No basis is provided for why changing the potential of the toner necessarily changes the potential of the surface of the photosensitive drum.

The prior patent is directed at a pre-transfer lamp for enhancing toner transfer efficiency by changing the potential of the toner. Applicant now attempts to narrowly tailor claims to an exposing device to expose the surface of the photosensitive drum, which is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Regarding the rejection under 35 USC §102, Applicant argues that limitation in the preamble were not mentioned in the rejection, thus not affording a fair opportunity to respond. Response, p. 12. Applicant acknowledges that preamble limitation must be incorporated into the

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body of the claim, but fails to explain how any of the preamble limitations are incorporated into the body of the claim. Applicant also asserts that the erase device (12) of Fox does not spread light in a scan direction of the photosensitive member because the exit surface is flat. Response, p. 12-13. However, figure 2 shows spreading light in the scan direction.

Contact Information

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

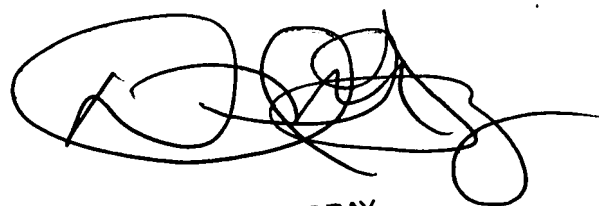
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Gleitz whose telephone number is (571) 272-2134. The examiner can normally be reached on Monday-Friday between 9:00AM and 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on (571) 272-2119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rg



DAVID M. GRAY
SUPERVISORY PATENT EXAMINER